

**REMARKS**

This amendment is in conformance with the suggestions kindly advanced by the Examiner and the Supervisory Primary Examiner during the telephone discussions with Applicant's undersigned attorney on Monday, the 9<sup>th</sup> of August 2004

**I. Status of the Claims**

Claims 1 through 60 are pending. Upon entry of this Amendment, Claims 21 through 60 will be pending in this reissue application. No amendments have been introduced. In accordance with the discussion between the Examiners and Applicant's undersigned attorney, only upon issuance and grant of a reissue patent upon Applicant's co-pending reissue assigned Serial No. 10/314,937 filed on the 9<sup>th</sup> of September 2002, will claims 1 through 20 be cancelled. In other words, the cancellation of allowed claims 1 through 20 is contingent upon occurrence of a condition precedent, the issue and grant of a reissue patent upon Applicant's co-pending reissue assigned Serial No. 10/314,937. Absent this contingent precedent, claims 1 through 20 remain pending.

The necessity for this contingency in entering a cancellation of allowed claims 1 through 20 arises in recognition of the propensity of the Office to repeatedly delay completion of examination in both the above-captioned application and in the co-pending reissue assigned Serial No. 10/314,937, a continuation of the above-captioned reissue application presenting allowed claims 1 through 20. Specifically, a *Notice of Allowance* was prepared by the Examiner

upon completion of the examination of Serial No. 10/314,937, Serial No. 10/314,937 was then reviewed by the Special Program Examiner and additional language was drafted by the Special Program Examiner on the 29<sup>th</sup> of March 2004 for insertion into the Examiner's *Reasons For Allowance*, but the Commissioner has been unable to issue a *Notice of Allowance* or any other correspondence in Serial No. 10/314,937 since prior to the 29<sup>th</sup> of March 2004. Moreover, the prosecution history for Serial No. 10/314,937 does not state whether a second PALM flag has been set or whether the TC SPRE has undertaken the final review, or even whether OPLA has begun its screening process. These steps as outlined in §1456 of the *Manual of Patent Examining Procedure* (8<sup>th</sup> Ed., Rev. 1, April 2004) must be completed before Serial No. 10/314,937 is issued. Should the Board of Appeals complete its *Decision on Appeal* before either the TC SPRE has completed the final review, or before OPLA has completed its screening process of Serial No. 10/314,937, there would probably be no purpose in both paying an issue fee in Serial No. 10/314,937 and in cancelling allowed claims 1 through 20 in the above-captioned application. Consequently, Applicant respectfully makes cancellation of allowed claims 1 through 20 contingent upon a condition precedent of issue and grant of a reissue patent on Serial No. 10/314,937 in recognition of the likely possibility that the Commissioner may never make a timely issue or grant of claims 1 through 20 in Serial No. 10/314,937, and that upon completion of the pending appeal, it will be both less expensive and quicker to permit allowed claims 1 through 20 to go to issue in the above-captioned application; this option must be preserved and may not be equitably denied to the Applicant where the primary cause for the continued co-pendency of Serial No. 10/314,937, even though all claims are allowed, is procrastination by the

Office.

In accordance with MPEP §1453(c), from the 2 May 2004 revised edition, there is no need to present the patent claims 1-20 surrounded by brackets if there is a direction to cancel the claims.

## **II. Rejection of Claims 21-51 Under 35 U.S.C. §251**

In paragraph 2 of the Office action, the Examiner rejected claims 21 through 51 under 35 U.S.C. §251 “as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based.” During the telephone conversations, the Examiner has stated that this rejection of claims 21 through 51 inclusive, has been withdrawn and that a second *Examiner's Answer* would be issued confirming the withdraw of the rejection of claims 21 through 51 under 35 U.S.C. §251. Such action is respectfully requested.

The several, and continuing courtesies extended by the Supervisory Primary Examiner, and by the Special Program Examiners to Applicant's undersigned attorney, and to the Applicant, is noted with great appreciation.

In view of the above, all claims are deemed to be allowable and this application is believed to be in condition to be passed to issue. Reconsideration of the rejections is requested.

Should any questions remain unresolved, the Examiner is requested to telephone Applicant's attorney.

Respectfully submitted,



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